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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,584	02/12/2002	David Lawrence	G08.018	8233
27383	7590	11/25/2003		
CLIFFORD CHANCE US LLP 200 PARK AVENUE NEW YORK, NY 10166			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary	Application No.	Applicant(s)	
	10/074,584	LAWRENCE, DAVID	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Original claims 1-40 have been examined. The restrictions and rejections are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: The claims 1-37 are drawn to a computer-implemented method, system, computer program code and computer data signal for managing risk associated with regulation.

Invention II: The claims 38-40 are drawn to a method of interacting with a network access device so as to manage risk relating to a risk subject.
3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as managing risk associated with regulation without necessarily using the method of interaction with a network access device recited in invention II. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Joseph Kincart on November 12, 2003, a provisional election was made to prosecute the invention of a computer-implemented method, system, computer program code and computer data signal for managing risk associated with regulation, claims 1-37. Affirmation of this election must be made by the applicant in replying to this Office action. Claims 38-40 are withdrawn from further consideration by the examiner,

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37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Basch et al (US Patent 6,119,103) in view of Irving et al (US Patent 5,991,743).

With reference to claims 1, 24, 34, 36 and 37 Basch teaches a computer-implemented method, a computerized system, a computer executable program code residing on a computer readable medium and a computer data signal for managing risk, the method comprising: gathering relevant data from multiple sources; and receiving an inquiry relating to a risk subject or data descriptive of a risk subject (See Basch Figure 1, Column 5 line 8 – Column 6 line 8, and Claims 1, 21, 26). Communication network, executable software stored on the server and executable on demand and the computer data signal are inherent in the invention of Basch.

Basch does teach the steps of aggregating the data gathered according to risk variables; associating portions of the aggregated data with the risk subject; and transmitting the associated portions of the aggregated data.

Irving teaches the steps of aggregating the data gathered according to risk variables; associating portions of the aggregated data with the risk subject; and transmitting the associated

portions of the aggregated data (See Irving Figure 2, Abstract, Column 2 lines 40-41, Column 3 lines 4-37 and Claim 1).

It would have been obvious to one with ordinary skill in the art at the time of invention to include the disclosure of Irving to the invention of Basch. The combination of the disclosures taken as a whole suggests that it would have helped the client manage the risk associated with the risk subject in a timely and efficient manner.

With reference to claim 2, Irving teaches the step wherein the gathered data is gathered exclusively from publicly available sources (See Irving Column 3 lines 16-20)

With reference to claims 3-6, Irving teaches communication involving system-to-system batch requests (See Irving Column 3 lines 51-57) and communications received electronically, via facsimile, and via voice communication (See Irving Column 2 lines 44-45).

With reference to claims 9, 14, 23, 25-33 and 35 Irving teaches the steps wherein the gathered data does relates to commercial entities (See Irving Column 3 lines 6-10); wherein the gathered data related relevant to regulation accurately reports on or consists of a governmental record (See Irving Column 3 lines 16-20, lines 33-37); continually monitoring the aggregated data and transmitting any new information related the risk subject (See Irving Column 3 lines 51-57); enhancing the gathered data including data descriptive of the risk subject and scrubbing the data to incorporate new information (See Irving Column 6 line 66- Column 7 line 10); augmenting the associated portions of aggregated data (See Irving Column 6 lines 9-17); associating portions of aggregated data comprises relevance ranking (See Irving Column 5 lines 51-55); receiving a source of gathered data and transmitting the source of the associated portions of aggregated data (See Irving Column 6 lines 9-17); and wherein the data is gathered via an

electronic feed (See Irving Column 2 lines 35-39). Enhancing data is interpreted to include using index files and augmenting aggregate data is interpreted to include using data mining and Boolean logic. Alternatively these steps are old and well known in the art. These steps make the process of enhancing or augmenting data more efficient.

With reference to claims 7, 8, 10-12 and 20-22, Basch teaches the steps wherein transmitting the associated portions of the aggregated data to institutions by transmitters covered by Gramm-Leach-Bliley Act is conditioned upon receipt of a contractual obligation to limit use of the aggregated data for complying with regulatory and legal obligations associated with fraud and the prevention or detection of a crime (See Basch Column 5 lines 35-45) and wherein the risk subject comprises details descriptive of a financial transaction, parties involved in a financial transaction, and wherein the inquiry relating to a risk subject comprises an alert list (See Basch Figure 1). The step of transmitting data to recipients conditioned upon receipt of a contractual obligation to limit use in compliance with regulatory and legal obligations is implied in the disclosure of Basch. Such receipts protect the transmitter from legal problems if the recipient misuses the information.

With reference to claims 13 and 15-19, Basch and Irving combined do not explicitly teach the steps wherein the gathered data relevant to regulation does not include information sourced from a credit report; insuring that the source of gathered data relevant to regulation is reputable; wherein none of the associated portions of the aggregated data transmitted comprises any content created or developed by a provider of the computer-implemented method for managing risk associated with government regulation or none of the aggregated data comprises any consumer reporting data; and the step of generating a report relates to a financial institution's

obligation to know their customer or a financial institution's obligation to file Suspicious Activity Reports.

Official notice is taken that these steps are old and well known in the art. These steps help ensure that only relevant data is collected from properly selected sources and that the laws and regulations are followed by all the parties to the transaction.

It would have been obvious to one with ordinary skill in the art at the time of invention to include these steps to the combined disclosures of Irving and Basch. The combination of the disclosures taken as a whole suggests that it would have helped all parties using the system ensure that only relevant data is collected from properly selected sources and that the laws and regulations are followed by all the parties to the transaction.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian

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November 12, 2003

Richard Weisberger
Primary Examiner

